

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, has tentatively rejected all claims. On a substantive basis, the Office Action has alleged that the claims are obvious over the combination of U.S. Patent 6,693,896 to Utsumi et al (hereafter ‘896 patent or Utsumi) and U.S. Patent 6,542,942 to Gulati (hereafter ‘942 patent or Gulati). For at least the reasons set forth below, Applicant respectfully disagrees and requests reconsideration and withdrawal of the rejections.

Status of FINAL Should be Withdrawn

As an initial matter, the Office Action has been accorded the status of FINAL, alleging that Applicant’s prior amendment necessitated the new grounds for rejection. Applicant respectfully traverses this rationale, as the only substantive amendment made in response to the prior Office Action was the addition of the word “computer” in the preamble of the independent claims. This amendment should not have necessitated additional searching or new grounds of rejection. In fact, as Applicant noted in its prior response, the amendment was made merely to confirm the only reasonable interpretation that could have been accorded to the claims in the first place. No deviation in claim scope was intended by the amendment. To now allege, as the Office Action does, that the amendment so changed the claim scope and interpretation, is tantamount to an admission that the prior Office Action construed the claims without ANY reference or consideration of the fundamental teachings of the specification (ergo, the essence of the Applicant’s invention).

In this regard, the MPEP requires that the initial search be more thorough than apparently the one was in this application. For example, MPEP 704.01 requires that “[t]he invention should

be thoroughly understood before a search is undertaken." More significantly, MPEP 904.03 requires that:

...It is normally not enough that references be selected to meet only the terms of the claims alone ... but the search should ... also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment....

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention...

In view of these, and other MPEP requirements, it is clear that that the '896 patent should have been cited in the previous Office Action. As the previous Office Action failed to cite this reference (which is now the primary reference of the present rejections), the FINAL status of the current office action is clearly premature and should be withdrawn.

For at least this reason, Applicant respectfully submits that the status of FINAL from the prior Office Action be withdrawn.

Discussion of Rejections

Fundamental Distinction of All Claims Over Cited References

Turning now to the substance of the Office Action, the Office Action has rejected all claims as allegedly obvious over the combination of Utsumi and Gulati. Applicant respectfully disagrees. The summary of the present application states:

The present invention is broadly directed to a system and method for accessing software components, interfaces, or resources in a distributed network environment. *A distinctive feature of the invention is its ability to locate such components, interfaces, or resources based upon certain specified attributes, and without having prior knowledge of the address or location of the component, interface, or resource.*

(*Emphasis added.*) This stated essence of Applicant's invention cannot be achieved in the system of Utsumi (or the combination of Utsumi with Gulati). This broadly-stated objective or feature is achieved, in certain embodiments, by the broadcast (over a network) of a request for a component that has at least one attribute specified in the request. In addition to other features, every independent claim of the present application embodies at least the three features/concepts, which are underlined above. The rejections applied by the Office Action, however, have either blurred or ignored these features. For at least this reason, the rejections are misplaced and should be withdrawn. Further, the system disclosed in Utsumi relates to the reservation of a resource at the request of a user. The system of Utsumi, as described, requires *a priori* knowledge by the user of the resources of the system. In contrast, and as noted above, the presently-pending claims define systems and methods which have the "ability to locate such components, interfaces, or resources based upon certain specified attributes, ***and without having prior knowledge of the address or location of the component, interface, or resource.***"

Further still, the system of Utsumi relates to the reservation of a resource at the request of the user. In contrast, the claimed invention relates to the identification of available components and not necessarily the reservation of the components. As an example, the specification describes a scenario in which a user specifies the component of a network printer having the attribute of color printing capability. In response to such a broadcasted request, the relevant network printers would reply to the request. The service consumer (e.g., user's system) would then have an identification of the network printers capable of printing in color. At this point, however, none of the printers have been allocated to process a print job (e.g., these resources have not been reserved, but merely identified).

For at least these fundamental reasons, the application of Utsumi to the pending claims is misplaced and should be withdrawn.

Notwithstanding the foregoing global distinction that is applicable to all claims, each independent claim will be individually discussed below.

Claims 1-11

Turning now to the rejected claims, the Office Action rejected independent claim 1 as allegedly obvious over the combination of Utsumi in view of Gulati. For at least the reasons set forth below, Applicant respectfully disagrees.

Independent claim 1 recites:

1. In a ***distributed computer networked system*** having at least one service consumer and at least one service provider, a method for accessing a remote software component by a service consumer comprising:
generating a request for a component having at least one specified attribute;
broadcasting the request across the network;
receiving the request at a service provider;
comparing at least one specified attribute of the received request with component attributes of the service provider; and
communicating a response to the requesting service consumer.

(*Emphasis added.*) Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

As an initial matter, Applicant notes that, with regard to the claimed element of “broadcasting the request across the network,” that the Office Action misinterpreted this element as “transmitting.” In this regard, the Office Action alleged (paragraph 4(b)) that “Utsumi has taught ... b. transmitting the request across the network (Col. 1 line 67-Col 2 line 4).” (*Emphasis added*). “Transmitting” is a broader term than “broadcasting” (as the term is used in the context

of the pending claims), and as such, the two cannot properly be treated as the same. Pages 13-15 of the present application describe the term “broadcast” in pages 13-15 to mean the communication, in a distributed network, of a message to a large number devices on the network. The specification describes that, although a number of broadcasting methodologies could be utilized (p. 15, lines 5-6), UDP multicast messaging is preferred, as confirming reliable delivery to every device is not essential (p. 13, lines 20-24 and p. 15, lines 6-19). This alone reflects an error on the part of the Office Action that warrants withdrawal of the rejection.

In addition to the foregoing, col. 1 line 67 through col 2 line 4 or Utsumi (the teaching of Utsumi relied upon for teaching the claimed “broadcasting ...” feature) actually states:

An information receiving apparatus according to the present invention, which is connected to an information providing apparatus by forming a connection in a communication network and which receives content information from the information providing apparatus through the connection...

As is clear from even a cursory reading, this portion of Utsumi does not teach, disclose, or suggest the claimed feature of “broadcasting the request across the network.” For at least this reason, the rejection of claim 1 is deficient and misplaced and should be withdrawn.

Further still, and in an effort to advance the prosecution of this application, the undersigned submits that the Office Action has characterized Figure 1 of Utsumi as disclosing the claimed “distributed computer networked system” (Office action, paragraph 4). However, the network disclosed in Figure 1 of Utsumi is an ATM network, which the specification describes as “an IP (Internet Protocol) network using an ATM (Asynchronous Transfer Mode), a connectionless IP packet needs to be transferred by a virtual connection ... as a connection-oriented technique which guarantees the quality.” (Col. 1, lines 28-33). A virtual connection (with endpoints defined by the AMInet routers 21 and 23), however, is inconsistent with a

distributed network, allowing for the “broadcast” of a message, as defined by claim 1. For at least this additional reason, the application of Utsumi to claim 1 is misplaced and should be withdrawn.

As a separate and independent basis for the patentability of claim 1, the Office Action alleges that Utsumi teaches “generating a request for a component having at least one specified attribute (Col 2 lines 4-5).” (*Emphasis added*, Office Action, paragraph 4a). Applicant respectfully disagrees. This cited portion of Utsumi actually states: “input means for inputting a command based on an operation by a user.” In applying this teaching to the relevant element of claim 1, the Office Action apparently equates “a command” with the claimed “request.” Although the Office Action does not clearly apply these teachings, it is presumed that the disclosed “operation” is being applied to equate to either the claimed “component” or the claimed “attribute.” Either way, it is clear that a claimed feature is missing from the cited teaching of Utsumi (as the disclosed “operation” cannot be both a “component” and an “attribute”), and for at least this reason the rejection is misplaced and should be withdrawn.

Notwithstanding, the undersigned respectfully submits that the cited teachings of Utsumi are significantly different than the claimed features of the present invention, and that the rejection generally embodies a rationale that is fundamentally misplaced. In this regard, the present application specifically defines “components” to include “services, interfaces, resources, code segments, etc.” (page 1, lines 19-21). Likewise, “attributes” are used to specify a component. By way of illustration, one example presented in the present application was a “request” by a computer for a “component” (resource) of a network printer having an “attribute” of color printing. In that example, the color attribute was used to specify the printer component that was the subject of the generated request. Simply stated, the cited teaching of Utsumi (*i.e.*, “input

means for inputting a command based on an operation by a user") cannot be applied (even with the broadest possible application) to disclose or suggest such a claimed feature. For at least this additional reason, the rejection is misplaced and should be withdrawn.

As yet another separate and independent basis for the patentability of claim 1, claim 1 calls for "*comparing at least one specified attribute of the received request with component attributes of the service provider.*" No such feature is taught, disclosed, or suggested in Utsumi. The Office Action alleged that this feature was disclosed at "col. 17 lines 26-28 and col. 2 lines 7-9). However, these locations of Utsumi actually disclose:

Next, a flexible set-up mechanism will be explained. In the ASP, resources can be reserved in various forms to use resources efficiently or to make resource reservation which matches with a request from an application....

.... control means for controlling the communication means so as to output an instruction signal, based on the command inputted through the input means.

As noted above, the system of Utsumi relates to resource allocation, in response to a user request for a resource. Utsumi does not disclose the request for a resource being specified by an attribute, and these above-disclosed portions of Utsumi certainly do not disclose this claimed feature. Instead, these portions of Utsumi disclose nothing more than the reservation of a resource in response to a user request. Claim 1, however, specifically claims the step of "comparing at least one specified attribute of the received request with the component attributes of the service provider." No such corresponding feature is disclosed or suggested in Utsumi. Therefore, for at least this additional reason, the rejection is misplaced and should be withdrawn.

For at least the foregoing reasons, the rejection of claim 1 should be withdrawn. For at least the same reasons the rejections of claims 2-11, which depend from claim 1, should be withdrawn as well.

Claims 12-19

The Office Action rejected independent claim 12 as allegedly obvious over the combination of Utsumi in view of Gulati. Claim 12 includes salient features of “means for generating a request … for a component having at least one specified attribute”, “means for broadcasting the request across the network” and “means for comparing the at least one specified attribute of the received request with component attributes of the service provider.” These features were discussed in connection with the rejection of claim 1, and therefore the rejection of claim 12 should be withdrawn for at least the same reasons as claim 1.

With regard to dependent claims 12-19, the rejections to those claims should be withdrawn insofar as they depend from claim 12, and the rejection of claim 12 should be withdrawn.

Claim 20

The Office Action rejected independent claim 20 as allegedly obvious over the combination of Utsumi and Gulati, for the same reason as claim 1 (Office Action, paragraph 18). Therefore, Applicant submits that the rejection of claim 20 should be withdrawn for at least the same reasons as claim 1.

Claim 21

Finally, the Office Action rejected independent claim 21 (paragraph 19) as allegedly obvious over the combination of Utsumi and Gulati. Claim 21 includes salient features of “generating a request for a component having at least one specified attribute”, “broadcasting the

request across the network” and “comparing, *at each of the plurality of service providers on the network*, the at least one specified attribute of the received request with component attributes of the service provider.” These features were discussed in connection with the rejection of claim 1, and therefore the rejection of claim 21 should be withdrawn for at least the same reasons as claim 1. In addition, claim 21 specifically provides that the “comparing” takes place “at each of the plurality of service providers on the network,” and further defines the “communicating, from each of the plurality of service providers, a response to the requesting consumer.” These added features are not disclosed in Utsumi. In this regard, the requested resource (in the system of Utsumi) will be allocated by only one provider (not a plurality of providers). As such, Utsumi cannot be properly applied to claim 21, and the rejection of claim 21 should be withdrawn.

Combination of Utsumi and Gulati is Improper

As a separate and independent basis for the patentability of all claims, Applicant respectfully submits that the combination of Gulati with Malik is improper and should be withdrawn.

The Office Action rejected all claims 1-21 as allegedly obvious over the combination of Utsumi and Gulati. In forming this rejection, the Office Action merely concluded that the combination of these two references would have been obvious “because the broadcasting method would facilitate the exchange of information, and multiple devices operatively connected to the network as taught by Gulati (Col 2 lines 18-21).” (Office Action, page 3, third paragraph). Ironically, this is identical (word-for-word) to the rationale espoused in the last Office Action for combining Gulati with Malik (a reference no long being applied). Applicant respectfully disagrees. Among other reasons for traversing this rejection, Applicant respectfully submits that

this rejection falls far short of the legal requirements for forming rejections under 35 U.S.C. § 103(a).

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991).

Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a system or method for accessing a remote software component by a service consumer over a distributed computer networked system, as defined by the pending claims.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The Office Action has failed to cite any apparent disadvantage of Utsumi, which would prompt the combination of select teachings of Gulati therewith.

For at least this separate and independent basis, the rejections of claims 1-21 should be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to Hewlett-Packard Company's deposit account No. 08-2025.

Respectfully submitted,

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